

REMARKS

Claims 1 - 15 are currently pending in the application. Claims 2, 4, 6, and 8 - 11 have been withdrawn as being subject to election/ restriction requirement. Claims 1, 3, 5 and 7 have been amended. No new claims have been added. No claims have been cancelled. The claim amendments find support throughout the application, including the claims and drawings as originally filed. No new matter has been added.

Rejection of Claims under 35 U.S.C. 112, first paragraph

Claims 1, 3, 5, 7, and 12 – 15 were rejected under 35 U.S.C. 112, first paragraph as containing new matter.

The Examiner argues that “in response to the first Office Action, applicants amended the specification, introducing a sequence listing containing fifteen sequences that were not part of the original disclosure (Office Action, p.2).” The Examiner argues that “Tables 1 – 3 list a number of identifiers of genes,” but allegedly “fail to indicate what the sequences are...nor provide clear identification of the intended sequences, nor where such can be obtained (Office Action, p. 2 – 3).”

Applicant respectfully traverses the rejection.

Applicant directs the Examiner to page 37 of the instant specification, which teaches:

The genes identified on the GEM array that are more highly expressed in Y-1 treated cells than control cells are listed in Tables 1, 2, 3 and 4 in order of decreasing differential expression. Each entry includes the I.M.A.G.E. Database Accession Number for the sequence. I.M.A.G.E. clones can be obtained from, e.g., the American Type Culture Collection (Manassas, V.) [emphasis added].

As pointed out by the Examiner and indicated on page 4 of the instant specification, the sequences that are presented in Tables 1 – 3 are based on Incyte's

mouse cDNA array, which is not publicly available. However, as stated above on page 37 of the specification, each entry in the table has an IMAGE clone accession number for identification. Thus, one of skill in the art can use one of the publicly available IMAGE consortium distributors (e.g., publicly available on the world wide web at image.llnl.gov/image/html/idistributors.shtml) to clearly identify any of the sequences listed in Tables 1 – 3, and even further obtain those IMAGE clones if desired.

The Examiner also argues that “the specification states that the genes of Table 1 are upregulated in ‘Y1’ cells, but fails to identify those cells (Office Action, p.3).”

Applicant directs the Examiner to page 7 of the Amendment filed on May 20, 2003, which states:

In further support of Applicant's arguments, it is noted that Y-1 cells are a clonal steroid-secreting cell strain initiated from a mouse adrenal cortex tumor (Yasumura Y et al., Cancer Res. 26: 529-536, 1966, courtesy copy enclosed), which has been deposited in ATCC under the catalogue code CCL-79 (as indicated in the application at page 35, lines 22-23). Y-1 cells have been described in several articles on the study of the expression and regulation of hormones such as progesterone.

Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of the claims

Next, the Examiner argues that amendment of the claims to include the phrase “at least a two-fold increase” is allegedly new matter. While in no way acquiescing to that position, solely in the interest of advancing prosecution, Applicant has amended the claims to delete this phrase.

As such, Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

Lastly, the Examiner has indicated that "should the new matter rejection be overcome, the rejection under 35 USC §112, first paragraph, would be maintained on the alleged basis of lack of adequate written description of 'human genes homologous' to the murine genes in question (Office Action, p.3)." Solely in an effort to advance prosecution, Applicant has amended the claims to delete this language.

For at least the foregoing reasons, Applicant submits that all claims are allowable as written and respectfully requests favorable reconsideration by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record.

Dated: March 5, 2007

Respectfully submitted,

By 
Christine C. O'Day

Registration No.: 38,256

EDWARDS ANGELL PALMER & DODGE LLP
P.O. Box 55874
Boston, Massachusetts 02205
(617) 439-4444
Attorneys/Agents For Applicant